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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,167	04/20/2005	Pierre Labeye	034299-631	8230
7590 Thelen Reid & Priest PO Box 640640 San Jose, CA 95164-0640				
			EXAMINER ALEXANDER, LYLE	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 06/11/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,167

Applicant(s)

LABEYE ET AL.

Examiner

Lyle A. Alexander

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The 4/609 amendments have added the new limitations to claim 1 " ... means operable to send back along said optical guiding plane towards the collection means ... " which are not clear as to the function of the "means." Claim 1 lines 1-5 claim luminescence is emitted by the sample in an optical guiding plane that is connected to a collection means. The Office has read these limitations as luminescent light travels from the sample to the optical guide and to the collection means. However, the lines 6-7 now claim "means operable to **send back along said optical guiding plane** towards the collection means ..." which is read as the light is being "sent back" or going in the opposite direction.

For the purposes of examination, claim 1 will be interpreted as luminescence travels from the sample to the optical guiding plane and then to the collection means.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Weisbuch et al. US 6,867,900.
2. See the appropriate paragraph of the 10/6/08 Office action for the teachings of Weinsbunch et al.
3. The 4/6/09 amendments have added new limitations to claim 1 and these same limitations are in new claim 12. Both claims have been rejected above under 35 USC 112 second paragraph. For the purposes of examination, these limitations are best understood as requiring the light to travel from the sample through the optical guiding plane and to the detector. The Office maintains Weinsbunch et al. teach several embodiments, such as in figure 4a, where the light passes through an optical member to guide the light to the collector. The Office maintains Weinsbunch et al. meet all of the claimed limitations.
4. New claim 12 substantially encompasses all of the limitations previously presented by the combination of claims 1 and 3. The Office maintains the position of the 10/6/08 Office action that the device of Weisbuch is formed on a substrate (col. 1 line 15), the optical guiding plane is a plane parallel to the substrate (Fig. 6, guiding structure 14) and the luminescence light detection means are arranged along a plane perpendicular to said plane parallel to the substrate (light is transmitted to the portion located above the surface, col. 12 lines 26-28).

Response to Arguments

Applicant's arguments filed 4/6/09 have been fully considered but they are not persuasive.

Applicant state Weisbunch et al. do not teach sending light **back** along the optical guiding plane. In light of the above 35 USC 112 second paragraph issues, it is not clear what is intended by sending the light **back** along the optical guiding plane.

Applicant states Weinsbunch et al. teach in figure 5 directing light out of the guiding plane and cannot be read on the instant invention. Weinsbunch et al. teach different embodiments, such as figures 4a that teaches light directed through the semi-reflective mirror(7) to the collector which is has been read on the claimed optical guiding plane and indistinguishable from the instant claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lyle A Alexander/
Primary Examiner, Art Unit 1797